

notify the seller associated with the accepted quote of the acceptance to facilitate purchase of the product.

70. A computing system according to claim 56, further comprising instructions to indicate on the RFQ that the set of attributes was received from a customer through an authenticated buyer.

71. A computing system according to claim 56, further comprising instructions to track a status of the transmitted RFQ's, and to selectively provide a customer with an update of the status of their request.

REMARKS

Applicant offers the foregoing amendments and the following remarks to the Office Action mailed July 25, 2001. In the Action Summary, it is noted that claims 1 and 32-71 stand rejected. With this response, Applicant offers to selectively amend claims 48-51 to remove lingering informalities identified therein. In addition, Applicant offers the following remarks traversing the basis for the remaining substantive rejection(s) of the currently pending claims. Applicant respectfully submits that this response should be entered as it amends the claims placing them in better condition for appeal, and removes one or more issues from appeal. Thus, in light of the offered amendments and the following remarks, Applicant respectfully requests that the finality of the Action be withdrawn and that the patentability of the pending application be reconsidered.

Claim Objections

In paragraph 3 of the Action, claim 60 is rejected for an informality identified therein. In response, Applicant has amended the claim, as above, to remove this informality. Accordingly, Applicant respectfully requests that the objection to such claim be withdrawn.

35 USC §112, first paragraph, Claim Rejections of Claims 50 and 51

In paragraphs 4 and 5 of the Action, claim 50 and 51 were rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention.

In response, Applicant offers to amend claims 48 - 51, as above, to remove the basis for such rejection. In particular, Applicant offers to replace "authenticated buyer" with -- intermediary-- in each of claims 48-51, as above. Applicant respectfully submits that, given such amendment, the specification adequately supports the amended claims (see, e.g., pg. 5, line 23 through pg. 6, line 6). Accordingly, upon entry of the offered amendments, Applicant respectfully requests that the §112, first paragraph rejections of claims 50 and 51 be withdrawn.

35 USC §103(a) Claim Rejections of Claims 1, 32-45, 54, 57-65, 67 and 68

In paragraph 7 of the Action, claims 1, 32-45, 54, 57-65, 67 and 68 were rejected as being unpatentable over the previously cited TechShopper article in view of well-known business practices under 37 CFR §103(a). In response, Applicant respectfully traverses the rejection of such claims.

Nabors, et al.
A/N: 09/188,863

- 9 -

Atty. Docket: 04606.P001

Claim 1

As introduced in the previous response, Claim 1, as amended, is generally directed to a method comprising:

receiving a set of product attributes denoting a customer's desired product configuration;
transmitting a request for quote (RFQ) to an automatically selected set of sellers, the RFQ including the customer's desired configuration; and
notifying the requesting customer upon receipt of quote(s) in response to the transmitted RFQ.

In the rejection of claim 1, the Action provides that the receiving, transmitting and notifying elements of claim 1 are inherent in the TechShopper reference, acknowledging that the TechShopper reference fails to disclose or suggest the automatic selection of sellers to which the RFQ is transmitted.

To overcome this limitation of the TechShopper reference, the invention of claim 1 is erroneously characterized in the Action as requiring that the automatic selection of sellers be performed by an intermediary; that the intermediary is akin to well-known brokerage service(s) established, *inter alia*, through Official Notice; and that merely automating a manual process such as the brokerage service to achieve the same result does not provide a basis for patentability, citing *In re Venner*. In summary, the basis for rejection of claim 1 is the inherent (i.e., not express) teachings of the TechShopper reference in combination with "well-known business practices" established through Official Notice. In response, Applicant traverses the bases for rejection of this claim.

Inherency

A rejection based on inherency requires that (1) the alleged inherent characteristic **must necessarily** be present, **and** (2) that the alleged inherent characteristic **necessarily flows** from the prior art reference would be so recognized by one of ordinary skill in the art (see, e.g., *In re Robertson*, 49 USPQ2d 1949 (CAFC 1999); *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746 (CAFC 1991); and MPEP §2112). The foregoing test is not satisfied by what the reference **may teach**, but what **must necessarily be present** (see, e.g., *SGS Thomson Microelectronics v. Int'l Rectifier Corp.*, 32 USPQ2d 1496 (CAFC 1994)). That is to say, in order for a claim element to be inherently taught by a reference, it **must necessarily be present** in the cited reference for the teachings of the reference to work, and that one of ordinary skill in the art would recognize that the claim element is inherent in the teachings of the reference. It is not enough that a claim element **may** flow from the reference.

In this case, despite the characterization in the Action, Applicant respectfully submits at least the Examiner's assertions that the TechShopper inherently teaches the particular receiving, transmitting and notifying elements of rejected claim 1 fails to meet the foregoing standard. That is, Applicant respectfully asserts that it would not be apparent to one skilled in the art that the TechShopper reference **must** work in the manner characterized in the Action. As developed above, the fact that the TechShopper reference **may** work in such a fashion fails to satisfy the established standard for obviousness rejections based on the inherent teachings of a reference. Accordingly, Applicant respectfully submits that the Action evidences impermissible hindsight reconstruction, using the claimed invention as a guide, in finding the cited elements of rejected claim 1 in the TechShopper reference.

Official Notice and *In re Venner*

Nonetheless, even if, arguendo, the TechShopper reference does inherently teach the cited claim elements, the Examiner concedes that the TechShopper reference fails to disclose or suggest the claimed automatic selection of sellers. Rather, the Examiner attempts to build a basis for asserting *In re Venner* using Official Notice. In response, Applicant respectfully traverses. More particularly, as detailed below, Applicant respectfully asserts that (1) there is no basis for the Examiner's reading of the intermediary into claim 1; (2) the claimed automatic selection process is not analogous to the brokerage service(s) cited; (3) the automatic selection process is not a literal automation of a manual process and, as a result, *In re Venner* is misapplied; and (4) the Examiner has employed impermissible hindsight reconstruction (or, more appropriately, deconstruction) using the claimed invention as a guide to conjure the "well-known business practices" that provide the basis for §103(a) rejection of claim 1.

In rejecting claim 1, the Action has characterized claim 1 as requiring the automatic selection of sellers be performed by an intermediary. In response, Applicant respectfully asserts that claim 1 does not contain the term: intermediary. Applicant acknowledges that, when the meaning of a claim term is unclear on its face, that the specification may be relied upon to determine the scope of the claim, but that is not the case here. However, well settled patent law provides that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite a different thing from 'reading limitations of the specification into a claim' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim" (*In re Prater*, 162 USPQ 541, 550-51 (CCPA 1969); MPEP §2111).

Nabors, et al.
A/N: 09/188,863

- 12 -

Atty. Docket: 04606.P001

In this case, Applicant respectfully submits that the claim is clear on its face, and that the Examiner is impermissibly reading unnecessary and unwarranted limitations into the claim. Although the Specification provides that, in certain enumerated *example* implementations of the claimed invention, the automatic selection process is performed by an intermediary, the Specification is likewise clear that these are merely illustrative examples of the broader claimed invention, and that other implementations are contemplated within the scope and spirit of the present invention. For example, it is contemplated within the scope and spirit of the pending application that server 22 may well perform the automatic selection process.

Thus, Applicant respectfully submits that the Action has impermissibly imported the requirement that the automatic selection be performed by the intermediary to provide a basis through which Official Notice of the brokerage service(s) could be made, followed by the rejection under *In re Venner*. Accordingly, Applicant respectfully submits that there is no basis for such a limitation being read into rejected claim 1, and respectfully requests the 103(a) rejection thereof be withdrawn.

Nonetheless, even if, for the purposes of argument, we consider claim 1 with the unwarranted limitation of the intermediary, the automatic selection of sellers as claimed in rejected claim 1 is not obvious in light of the "well-known" brokerage services cited in the Action. Despite the characterization in the Action, the intermediary described in the Specification is not obviated by a conventional brokerage service. Indeed, the real-estate brokerage services cited in the Action are often associated with, or represent, local builder(s), and often just represent a small subset of a local market of builders. In this regard, such conventional brokerage services suffer from a limited number of contacts/business resources.

In addition to the limited resources, the effectiveness of a conventional brokerage service of the type cited in the Action are often limited by the experience and intellectual capacity of the broker. Simply stated, manual brokerage services identified in the Action illustrate the limitations that the claimed invention was designed to overcome.

To wit, in contradistinction of the conventional brokerage services cited in the Action, the intermediary is implemented on a server system (e.g., 24), and employs a number of information resources, utilizing a number of explicit and implicit criterion, to provide a level of logic (intelligence), capability, and repeatability to the task that conventional brokerage services cannot match. The intermediary interacts with any of a number of database(s) comprising information associated with the customer and/or any of a number of local/remote dealers/manufacturers of products, utilizing express and inherent criterion in providing such services. In this regard, the intermediary described in the specification is not merely an automation of an otherwise manual process, but improves and expands on the conventional brokerage service paradigm.

Accordingly, Applicant respectfully submits that the Action's reliance on *In re Venner* is misplaced. In *Venner*, the invention in question was a timer-solenoid combination employed to automate an otherwise manual process of timing a cure process and throwing a manual switch once the process was complete. In short, the purported invention *was quite literally* the automation of an otherwise manual process, which the court held to provide an insufficient basis for patentability. As introduced above, the intermediary described in the pending application is not simply a literal automation of an otherwise manual process to obtain the same result.

Instead of *Venner*, a number of more relevant cases have been decided in the computer age, i.e., post 1959 *Venner* era decisions, which affirm and acknowledge the contribution of software-type inventions. As provided above, implementing the intermediary function in software on a server-based system not only enables the process to be completed more quickly, as characterized by the Office, but also enables the use of any of a number of available information sources (databases) in a reasonable time fashion, utilizing express and implied customer and dealer/manufacturer characteristics to implement the intermediary services and, as such, greatly reduces the adverse effects of experience and intellectual capacity limitations often associated with the conventional brokerage services cited by the Office.

Accordingly, Applicant respectfully submits that the Examiner has employed impermissible hindsight reconstruction, using the detailed description of the pending application as a blueprint to find inventive aspects of the invention in the prior art.

In light of the foregoing, Applicant respectfully asserts that the rejection of claim 1 has been traversed on the grounds that (1) the TechShopper reference does not inherently teach that which is claimed in rejected claim 1; (2) that the Examiner has improperly imported the intermediary limitation into the interpretation of claim 1; (3) that the intermediary is not merely a literal automation of an otherwise manual process; and (4) that the Examiner has improperly applied hindsight reconstruction to conjure a basis for Official Notice with which to apply *In re Venner*. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Claims 55 and 56

Applicant respectfully submits that claims 55 and 56 include claim elements similar to those discussed above in amended claim 1 and are, therefore, likewise patentable over the TechShopper reference in view of the so-called well-known business practices employing arguments analogous to those presented above. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

Dependent Claims 32-45, 54, 57-65, 67 and 68

Applicant submits that, in addition to any independent basis for patentability, claims 32-45, 54, 57-65, 67 and 69 are dependent on patentable base claims 1 or 56 and are, in this regard, patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the rejection of such claims be withdrawn.

35 USC §103(a) Rejection of Claims 52-53 and 71

In paragraph 8 of the Action, claims 52-53 and 71 were rejected as being unpatentable over the TechShopper reference in view of well-known business practices in further view of a patent issued to Walker (USP 5,794,207) under §103(a). In response, Applicant respectfully traverses the rejection of such claims.

In accordance with Applicant's past characterization of the Walker reference, Applicant respectfully submits that the Walker reference is not cited as curing and does not, in fact, cure the limitations of the TechShopper and "well-known" business practices presented above. In this regard, Applicant respectfully asserts that claims 1, 55 and 56 remain patentable over the cited TechShopper, conventional business practices, and Walker references.

Applicant notes that, in addition to any independent basis for patentability of claims 52, 53 and 71, such claims are dependent on otherwise patentable base claims 1 or 56 and are, likewise patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

35 USC §103(a) Rejection of Claims 30, 31, 46-49, 57, 58, 69 and 70

In paragraph 9 of the Action, claims 30, 31, 46-49, 57, 58, 69 and 70 were rejected as being unpatentable over the TechShopper reference in view of well-known business practices in further view of a patent issued to Dworkin (USP 4,992,940) under §103(a). In response, Applicant respectfully traverses the rejection of such claims.

In accordance with Applicant's past characterization of the Dworkin reference, Applicant respectfully submits that the Dworkin reference is not cited as curing and does not, in fact, cure the limitations of the TechShopper and "well-known" business practices presented above. In this regard, Applicant respectfully asserts that claims 1, 55 and 56 remain patentable over the cited TechShopper, conventional business practices, and Dworking references.

Applicant notes that, in addition to any independent basis for patentability of claims 30, 31, 46-49, 57, 58, 69 and 70, such claims are dependent on otherwise patentable base claims 1 or 56 and are, likewise, patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

Conclusion

In light of the foregoing amendments and remarks, Applicant respectfully asserts that claims 1 and 32-71 are in condition for allowance, and earnestly awaits notice thereof. Absent a notice of allowance, Applicant respectfully requests that the finality of the Action be withdrawn. **In an effort to expedite prosecution of this matter, the Examiner is invited to call the undersigned counsel for the Applicant to discuss any further issues preventing allowance of the currently pending claims.**

Please charge any shortages and credit any overages to our Deposit Account No. 02-2666.

Dated: October 19, 2001

12400 Wilshire Blvd.,
Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP



Michael A. Proksch
Registration No. 43,021

Appendix A:**Version of the Claims with Markings****In the Claims:**

Please amend the claims as follows:

48. (Amended) A method according to claim 1, wherein the received set of product attributes are received from an [authenticated buyer] intermediary on behalf of the requesting customer, wherein the authenticated buyer provides an indication, either explicit and/or implicit, that the customer has funds available to complete the purchase.

49. (Amended) A method according to claim 48, wherein the [authenticated buyer] intermediary is the customer.

50. (Amended) A method according to claim 48, wherein the [authenticated buyer] intermediary is one of a banking institution, lending institution, product representative associated with a manufacturer of the product, and/or a re-seller of the product.

51. (Amended) A method according to claim 48, wherein an indication that the set of attributes was received from the [authenticated buyer] intermediary denotes to the seller(s) that the customer is one or more of ready, willing and/or eligible to complete the purchase.

60. (Amended) A computing system according to claim 59, further comprising instructions to provide the customer with an indication that the requested set of attributes is not available upon receiving [a response] a negative response to the query.